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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,736	05/31/2000	Avner Shafrir	52817.000112	2786

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EXAMINER
ANDERSON, LARRY O

ART UNIT	PAPER NUMBER
2173	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/583,736	Applicant(s) SHAFRIR ET AL.	
	Examiner Larry O Anderson	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-29 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4-9, 13-15, 22-23, and 26-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, 9-11, 13-17, and 19-20 of copending Application No. 09/583,734.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 8, 9, 15, 22, and 23 of the present application corresponds to claims 1, 6, 10, and 15 of the Application No. 09/583,734. The claims are identical in every aspect with the exception of the communication selection means, which is obvious and necessary in order to establish communications between one or more users. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 4, 5, 26, and 27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2, 7, 11, 16, and 17 of copending Application No. 09/583,734.

Claims 6, 13, and 28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4, 13, and 19 of copending Application No. 09/583,734.

Claims 7, 14, and 29 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5, 9, 14, and 20 of copending Application No. 09/583,734.

These are provisional double patenting rejections since the conflicting claims have not in fact been patented.

Information Disclosure Statement

1. The information disclosure statement filed 4/16/02 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog).

3. Regarding claims 1, 8, 9, 15, 22, and 23, Hotdog teaches user indicator presentation means for presenting user indicators associated with users within an electronic document (see Hotdog, where the author discloses lists of friends and co-workers notifying each other when they are on-line, and then later teaches using ICQ to add indicators to their websites allowing visitors to the site to communicate to the webmaster), enabling communication selection means

for a plurality of communication modes (see the 4th paragraph of Hotdog, where the author discloses real-time chats, exchanging files or URL's, sending direct messages back and forth, and launching a host of collaborative applications for Internet telephony, text chat, media, data and game functions), and a communication means or link for enabling a user to activate the indicators to initiate/establish the communication mode selected with the user indicator selected (see Hotdog, where the author discloses using the ICQ Communication panels to initiate communication between visitors to a site and a webmaster, using one of the communication modes selected).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2, 3, 10, 11, 16, 17, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog) in view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "How To Use ICQ" (hereinafter HowTo).

Regarding claims 2, 10, 16, and 24, Hotdog teaches all the limitations of claims 2, 10, 16, and 24, except for a teaching of communication prevention means. HowTo teaches communication prevention means (under heading entitled "Status Button", HowTo discloses several methods for preventing communications). It would have been obvious to one of ordinary

skill in the art, having the teachings of Hotdog and HowTo before him at the time the invention was made, to modify the user indicator system taught by Hotdog to include a communication prevention means, so as to allow for privacy as taught by HowTo (see heading "Status Button" of HowTo).

6. Regarding claims 3, 11, 17, and 25, Hotdog teaches all the limitations of claims 3, 11, 17, and 25, except for a teaching of an urgent communication request means for enabling users to override communication-preventing means and to send an urgent communication request. HowTo teaches an urgent communication request means (see HowTo under the "Status Button" heading, where HowTo discusses the Occupied feature, where a user can only send urgent messages to a user in occupied mode). It would have been obvious to one of ordinary skill in the art, having the teachings of Hotdog and HowTo before him at the time the invention was made, to modify the user indicator system taught by Hotdog to include an urgent communication request means, so as to allow a user to only receive urgent messages as taught by HowTo (see under "Status Button" heading of HowTo).

7. Claims 6, 7, 13,14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog) in view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "ICQ Has Features Consultants Need-And It's Free" (Evans). Hotdog teaches all the limitations of claims 6, 7, 13,14, except conference communication means and enabling users to share an application. Evans teaches conference communication means and enabling system users to share an application (see under the "Chat" bullet where Evans talks about chatting with a group, and later in the article discloses using

almost any collaborative software with ICQ, as well as sharing a chatting program with them). It would have been obvious to one of ordinary skill in the art, having the teachings of Hotdog and Evans before him at the time the invention was made, to modify the user indicator system taught by Hotdog to include conference communication and application sharing, so as to allow for business people to reach conclusions faster and conduct business as taught by Evans (see Evans under the "Chat" bullet).

8. Claims 4, 5, 26, and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog) in view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "Communicate online with your site visitors" (hereinafter Communicate). Hotdog teaches all the limitations of claims 4, 5, 26, and 27, except for a teaching of preference and communication options presenting means for presenting the communication options for receiving communications for a system user in an order preferred by the system user. Communicate teaches preference and communication options presenting means for presenting the communication options for receiving communications for a system user in an order preferred by the system user (see Communicate where the author discloses several different communications option preference presentation means, and whereby a website designer or other user can choose the way their incoming communications preferences will be ordered and displayed). It would have been obvious to one of ordinary skill in the art, having the teachings of Hotdog and Communicate before him at the time the invention was made, to modify the user indicator system taught by Hotdog to include preference and communication options presenting

means, so as to allow for different types of users with different preferences can receive communication according to those preferences (see the different templates of Communicate).

9. Claims 20, 21, 28, and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog) in view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "Communicate online with your site visitors" (hereinafter Communicate) and in further view of Mirabilis ICQ^{tm} as shown by "ICQ Has Features Consultants Need-And It's Free" (Evans). Hotdog and Communicate teach all the limitations of claims 20, 21, 28, and 29, except conference communication means and enabling users to share an application. Evans teaches conference communication means and enabling system users to share an application (see under the "Chat" bullet where Evans talks about chatting with a group, and later in the article discloses using almost any collaborative software with ICQ, as well as sharing a chatting program with them). It would have been obvious to one of ordinary skill in the art, having the teachings of Hotdog, Communicate, and Evans before him at the time the invention was made, to modify the user indicator system taught by Hotdog and Communicate to include conference communication and application sharing, so as to allow for business people to reach conclusions faster and conduct business as taught by Evans (see Evans under the "Chat" bullet).

10. Claims 12, 18, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis team up to bring ICQ to Hotdog users" (hereinafter Hotdog) in view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "How To Use ICQ" (hereinafter HowTo) and in further

view of Mirabilis ICQ98a, copyright 12/7/97, as shown by "Communicate online with your site visitors" (hereinafter Communicate). Hotdog and HowTo teach all the limitations of claims 12, 18, and 19, except for a teaching of preference presentation means and communication options presenting means for presenting the communication options for receiving communications for a system user in an order preferred by the system user. Communicate teaches preference and communication options presenting means for presenting the communication options for receiving communications for a system user in an order preferred by the system user (see Communicate where the author discloses several different communications option preference presentation means, and whereby a website designer or other user can choose the way their incoming communications preferences will be ordered and displayed). It would have been obvious to one of ordinary skill in the art, having the teachings of Hotdog, HowTo, and Communicate before him at the time the invention was made, to modify the user indicator system taught by Hotdog and HowTo to include preference and communication options presenting means, so as to allow for different types of users with different preferences can receive communication according to those preferences (see the different templates of Communicate).

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar user indicator communication systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry O Anderson whose telephone number is 703-305-7212. The examiner can normally be reached on M-F 7:20-3:50.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

loa
October 1, 2002

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100